

REMARKS

Claims 1-28 are pending in this application. Claims 1-18 and 20-28 are rejected under 35 U.S.C. § 112, first paragraph, and claims 1-8 and 16 are rejected under 35 U.S.C. § 102. Claim 19 is allowed.

Claim Rejections Under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 1-18 and claims 20-28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner states that:

The claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose how the inner member can be made in one-piece and the outer member can be made in one-piece. It is unclear how each of these members could be constructed according to the techniques disclosed by the applicant, as they are far more complex than any frame member made in one-piece according to the prior art. It is unclear how the members could be constructed without welding or joining in some manner smaller pieces to construct the inner or outer member.

The CAFC has indicated that the test of enablement is whether one reasonably skilled in the art could make or use the inventions from the disclosures in the patent contemplated with the information known in the art without undue experimentation. *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). A patent need not teach, and preferably omits, what is well known

in the art. In re *Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). See also MPEP 2164.01.

The Examiner disputes “that it is well know to use [the techniques of quick plastic forming, super plastic forming and hydroforming] to make a one-piece vehicle frame member of the size and shape depicted by applicant.” The Examiner advises, “If the process is readily apparent to one of ordinary skill in the art and no prior art reference can be found, then some explanation should be given as to why all prior art frames of similar size and complexity are made of multiple sections joined together rather than in one-piece as applicant suggests.”

Accordingly, Applicants have attached Declarations of engineers representing persons of ordinary skill in the arts of vehicle body and frame design and manufacture indicating that they would readily understand how to apply the methods discussed in the Application and/or incorporated therein by reference to make one-piece inner member and the one-piece outer member described. The attached Declarations under 37 C.F.R. § 1.132 of Richard Murray Kleber, Paul E. Krajewski and James G. Schroth are hereby incorporated by reference in their entirety. Additionally, per the Examiner’s request, an explanation is provided as to why Applicants’ one-piece inner and outer members may be larger than other prior art products formed using similar methods.

Claim Rejections Under 35 U.S.C. § 102(b)

The Examiner has rejected claims 1-8 and 16 under 35 U.S.C. § 102(b) as being anticipated by Schroeder et al., United States Patent No. 6,206,458. According to the Examiner, Schroeder et al. disclose:

a body and frame assembly for a vehicle comprising a one-piece inner member (16) mated with a one-piece outer member (12), each of the members defining door openings for opposing sides of the vehicle (the door openings of the inner member oppose the door openings of the outer member).

As may be seen in Figure 2 of Schroeder et al., the one-piece outer member 12 defines door openings for only the left side of a vehicle and the one-piece inner member 16 defines door openings for only the right side of the vehicle. However, under claim 1 and claims 8 and 16 which ultimately depend from claim 1, “*each* of [the inner and outer] members defin[e] door openings for opposing *sides* of the vehicle.” (emphasis added) Claim 1 requires that *each* of the inner and the outer member define door openings at opposing sides (plural). Thus each one defines door openings at the left side and the right side. As may be viewed in Figure 1a, and as described in paragraph [0015] of the Application, the outer member 10 forms door openings 22A and 23A extending from the outer roof panel portion first end 14 and door openings 22B and 23B extending from the opposing outer roof panel portion second end 16 (i.e., on opposite sides of a vehicle as shown in Figure 2a). Similarly, as illustrated in Figure 1b and described in paragraph [0022], the inner member 42 forms door openings 69A and 70A extending from the inner roof panel portion first end 46 and door opening 69B and 70B extending from the opposing inner roof panel portion second end 48 (i.e., on opposite sides of the vehicle as shown Figure 2a).

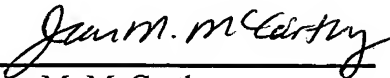
As stated above, Schroeder et al.’s inner member 16 and outer member 12 each only define door openings at one side of the vehicle (only together do they define door openings for opposing sides of the vehicle). For a rejection to be proper as an anticipation under 35 U.S.C. § 102, every element and limitation found in the rejected claim must be found in the 102 reference. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See MPEP §2131. Thus, because Schroeder et al. do not provide inner and outer members each of which define door openings for opposing sides of the vehicle, Schroeder et al. do not anticipate claim 1, nor claims 8 and 16 which depend therefrom.

Conclusion

In light of the above remarks and affidavits, it is believed that all claims are in condition for allowance, which action is respectfully requested.

Respectfully submitted,

TOMMY E. WHITE, et al.

By 
Jean M. McCarthy
Reg. No. 54,300

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QUINN LAW GROUP, PLLC
39555 Orchard Hill Place, Ste. 245
Novi, Michigan 48375
Phone: 248-380-9300
Fax: 248-380-8968

On behalf of:

Kathryn A. Marra
GENERAL MOTORS CORPORATION
Legal Staff Mail Code 482-C23-B21
P.O. Box 300
Detroit, Michigan 48265-3000